

U.S. Serial No. 10/678,468  
Reply to Office Action of: June 18, 2007  
Family Number: P2002J112 US2

Page 2

pour point less than  $-35^{\circ}\text{C}$ . Murphy and all the other references cited do not disclose a base stock with such a low pour point. Table 2 of Murphy shows lubricants formulated as an Automatic Transmission Fluid (ATF) with Hitec 434 (Ethyl Corp) wherein applicants are claiming the properties of a base stock with by definition does not include additives. Accordingly Examiner is requested to remove the rejection.

In addition, Examiner admits, "Applicant's invention differs in independent claims 1 and 13 by including property (iii)." Examiner then argues, "Although the premium synthetic lubricants of Murphy are not characterized by such values, the examiner is of the position that the claimed functional fluids may be the same as those disclosed in Murphy since the properties of VI and pour point may be the same, and since the claimed functional fluid may be prepared by the same process."

In the previous rejection, applicant's requested that the Examiner, "state specifically where in the prior art it teaches the claimed combination of specific steps to achieve the claimed properties or remove the rejection." The examiner did not address this request. Applicants have submitted an affidavit showing that unless the specific claimed steps are followed the claimed properties will not be achieved. The affidavit further states the prior art references are not an enabling disclosure. Examiner is picking and choosing various steps in the prior art based on hindsight reasoning with the benefit of applicant's disclosure. Once again, applicants are asking Examiner to state why she is picking each step from references listing many alternative steps and where does the prior art show that using such a combination of steps would result in the desired properties. Applicants are also requesting a statement on how the prior art enables the claimed invention including the claimed properties.

The Examiner's statement that, "Although the premium synthetic lubricants of Murphy are not characterized by such values, the examiner is of the position that the

U.S. Serial No. 10/678,463  
Reply to Office Action of: June 18, 2007  
Family Number: P2002J112 US2

Page 3

claimed functional fluids may be the same as those disclosed in Murphy since the properties of VI and pour point may be the same, and since the claimed functional fluid may be prepared by the same process" is pure speculation without any supportive evidence. As stated above, her statement is further refuted by the expert affidavit submitted by applicants. Applicants are officially challenging this factual assertion as not properly officially noticed or not properly based upon common knowledge.

MPEP §2144.03(c) States, "If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence. Applicant's affidavit clearly states the "cited references are not an enabling disclosure" and "The prior art does not disclose the importance of hydrodewaxing with a dewaxing catalyst in combination with the other steps to produce a lubricating oil with the claimed properties." Applicants further supported this with comparative data that demonstrates unless the proper steps are followed in the specification the claimed properties would not be achieved. 37 CFR 1.104(d)(2) requires, "When a rejection in an application is based on facts within the personal knowledge of an employee of the office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanations by the affidavits of the applicant and other persons." Accordingly, Applicants are requesting under 37 CFR 1.104(d)(2) an affidavit on how a person skilled in the art would know that following a specific combination of steps would result in a base stock with certain claimed properties that are not disclosed in the prior art without the hindsight benefit of applicant's disclosure.

In addition, the Examiner did not address several dependant claims. These claims include a functional fluid with an additive package without a viscosity index improver (claim 8). Many of the low temperature properties including viscosity index

U.S. Serial No. 10/678,460  
Reply to Office Action of: June 18, 2007  
Family Number: P2002J112 US2

Page 4

and pour point are achieved without viscosity index improvers. Examiner ignores the fact that many of the cited references are for fully formulated base stocks whereas applicant's claim improved properties from the base stock. In addition, applicants are also claiming various improvements to Brookfield viscosity at -20°F (claims 6 through 12) that were not addressed by the Examiner. The Examiner fails to show where the prior art shows these types of oils and lubricants have the claimed properties. Accordingly, Examiner should remove the rejection or at least remove the final rejection until these limitations are addressed.